IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

George W. Fitzmaurice, et al.

Serial No. 10/684,579   Group Art Unit: 2179

Confirmation No. 1747

Filed: October 15, 2003   Examiner: Tuyetlien T. Tran

For: PAN-ZOOM TOOL

<u>APPLICANT APPEAL BRIEF UNDER 37 C.F.R. §41.37</u>

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Sir:

In a Notice of Appeal filed May 11, 2009 the Applicant appealed from the Examiner's final Office Action rejecting claims 1-34.

Submitted herewith is an Applicant Appeal Brief under 37 C.F.R. § 41.37, and the requisite fees set forth in 37 C.F.R. §41.20(b)(2).

If any further fees are required in connection with this filing, please charge or Deposit Account No. 19-3935.

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I. REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest is Autodesk, Inc. of San Rafael, California, the assignee of the subject application.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))

Appellants believe that a co-pending Appeal in 10/684,580 may be related to, directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))

Claims 1-34 are rejected. Claims 1-7, 9-18, and 20-34 are being appealed.

IV. STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

In the final Office Action, claims 1, 19-21, 32, and 34 were objected to and the Examiner made suggestions for amendment. These suggestions have been adopted in a concurrently filed Amendment. The concurrently filed Amendment has not yet been entered but it is expected it will be as it adopts the Examiner's suggestions.

The claims of the appendix reflect the amendments of the concurrently filed Amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

The independent claims being appealed are 1, 22, 29, and 30-33.

The dependent claims being appealed are 2-7, 9-18, 23-28, and 34.

A. Independent Claim 1

1.   (currently amended) A graphical user interface ~~displayed~~ ~~on a~~ display, comprising:

Support: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10.

a first region control initiating a first function when activated;

Support: See, for example, the present Application, paragraphs [0029] and [0030], Figures 1a and 1b, reference numeral 14.

a second region control associated with the first region control having an outer edge and initiating a second function;

Support: See, for example, the present Application, paragraph [0029] and [0031], Figures 1a and 1b, reference numeral 16.

a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the ~~menu~~ interface and controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated; and

Support: See, for example, the present Application, paragraph [0032]-[0035], Figure 2, 3a 3b, reference numerals 10, 20, 30, 32.

a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions.

Support: See, for example, the present Application, paragraph [0029], [0032], [0033], [0055], Figures 1a, 1b, Figure 2, reference numerals 12, 14, 16, 20, 320.

Independent claim 1 recites a graphical user interface display. See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10. The summary of the claimed subject matter for claim 1 is as follows.

The graphical user interface display includes a first region control initiating a first function when activated.   See, for example, the present Application, paragraphs [0029] and [0030],

Figures 1a and 1b, reference numeral 14.

The graphical user interface display also includes a second region control associated with the first region control having an outer edge and initiating a second function. See, for example, the present Application, paragraph [0029] and [0031], Figures 1a and 1b, reference numeral 16.

Additionally, the graphical user interface display includes a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the interface and controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated. See, for example, the present Application, paragraph [0032]-[0035], Figure 2, 3a 3b, reference numerals 10, 20, 30, 32.

Finally, the graphical user interface display includes a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions. See, for example, the present Application, paragraph [0029], [0032], [0033], [0055], Figures 1a, 1b, Figure 2, reference numerals 12, 14, 16, 20, 320.

B. Independent Claim 20

20.   (currently amended) A user interface displayed on a display, comprising:

Support: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10.

a movable control having a first function activatable in an entire peripheral region of the control and a second function activatable in a central region of the control having an exterior edge; and

Support: See, for example, the present Application, paragraph [0029]-[0031], Figures 1a and 1b, reference numerals 10, 14, 16.

a tracking symbol movable within the control and moving the control when the exterior edge of the peripheral region is encountered and the control is always visible when one of the functions is not activated and always not visible when one of the functions is activated.

Support: See, for example, the present Application, paragraph [0029], [0032], [0033], [0034] Figures 1a, 1b, 2, 3a 3b, reference numerals 10, 12, 20, 30, 32.

Independent claim 20 recites a user interface display. See, for example, the present

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Application, paragraph [0029], Figures 1a and 1b, reference numeral 10. The summary of the claimed subject matter for claim 20 is as follows.

The user interface includes a movable control. The movable control includes a first function activatable in an entire peripheral region of the control and a second function activatable in a central region of the control having an exterior edge. See, for example, the present Application, paragraph [0029]-[0031], Figures 1a and 1b, reference numerals 10, 14, 16.

The user interface control also includes a tracking symbol movable within the control and moving the control when the exterior edge of the peripheral region is encountered and the control is always visible when one of the functions is not activated and always not visible when one of the functions is activated. See, for example, the present Application, paragraph [0029], [0032], [0033], [0034] Figures 1a, 1b, 2, 3a 3b, reference numerals 10, 12, 20, 30, 32.

C. Independent Claim 21

> 21.   (Currently Amended) A user interface displayed on a display, comprising:
>
> *Support*: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10.
>
> a tracking menu having a first function activatable in an entire peripheral region of the menu and having an exterior edge, a second function activatable in a central region of the menu and a tracking symbol tracking a position of a user positionable input transducer and causing the menu tool to move when the exterior edge is encountered and the menu is always visible when one of the functions is not activated and always not visible when one of the functions is activated.
>
> *Support*: See, for example, the present Application, paragraph [0029]-[0034], Figures 1a, 1b, 2, 3a 3b, reference numeral 10, 12, 14, 16, 20, 30, 32, 320.

Independent claim 21 recites a user interface display. See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10.

The user interface display includes a tracking menu. The tracking menu has a first function activatable in an entire peripheral region of the menu and having an exterior edge, a second function activatable in a central region of the menu and a tracking symbol tracking a position of a user positionable input transducer and causing the menu tool to move when the exterior edge is encountered and the menu is always visible when one of the functions is not activated and always not visible when one of the functions is activated. See, for example, the present Application, paragraph [0029]-[0034], Figures 1a, 1b, 2, 3a 3b, reference numeral 10,

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12, 14, 16, 20, 30, 32, 320.

D. Independent Claim 22

22.   (previously presented) A method, comprising:

displaying a pan-zoom tracking menu tool having an exterior edge;

> ***Support***: See, for example, the present Application, paragraphs [0029], [0032], [0055], Figures 1a, 1b, reference numerals 10, 324.

allowing a user to select pan and zoom operations using the tracking menu tool and an input transducer;

> ***Support***: See, for example, the present Application, paragraphs [0029]-[0031], [0055], Figures 1a, 1b, 2, 23, reference numerals 10, 14, 16, 320.

performing a selected one of the pan and zoom operation responsive to movements of the input transducer by the user and causing the menu to move when the exterior edge is encountered;

> ***Support***: See, for example, the present Application, paragraphs [0030]-[0033], Figure 2, reference numerals 12, 14, 16, 20, 320.

presenting the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated.

> ***Support***: See, for example, the present Application, paragraph [0034], Figures 3a and 3b, reference numerals 10, 30, 32.

Independent claim 22 is a method claim. The summary of the claimed subject matter for claim 22 is as follows.

The method includes displaying a pan-zoom tracking menu tool having an exterior edge. See, for example, the present Application, paragraphs [0029], [0032], [0055], Figures 1a, 1b, reference numerals 10, 324.

The method further includes allowing a user to select pan and zoom operations using the tracking menu tool and an input transducer. See, for example, the present Application, paragraphs [0029]-[0031], [0055], Figures 1a, 1b, 2, 23, reference numerals 10, 14, 16, 320.

The method also includes performing a selected one of the pan and zoom operation responsive to movements of the input transducer by the user and causing the menu to move when the exterior edge is encountered. See, for example, the present Application, paragraphs [0030]-[0033], Figure 2, reference numerals 12, 14, 16, 20, 320.

Finally, the method includes presenting the menu as always visible when one of the

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operations is not activated and always not visible when one of the operations is activated. <u>See, for example,</u> the present Application, paragraph [0034], Figures 3a and 3b, reference numerals 10, 30, 32.

E. Independent Claim 29

29.   (previously presented) An apparatus, comprising:

a display;

      Support: <u>See, for example,</u> the present Application, paragraph [0055], Figure 23, reference numeral 324.

a pen type input transducer; and

      Support: <u>See, for example,</u> the present Application paragraphs [0029] and [0055], Figure 23, reference numeral 320.

a computer coupled to the display and transducer and providing a pan-zoom tracking menu on the display and allowing a user to select and perform pan and zoom operations using the transducer input and moving the menu when an outer edge of the menu is encountered displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated.

      Support: <u>See, for example,</u> the present Application, paragraphs [0029]-[0034], [0055], Figures 1a, 1b, 2, 3a, 3b, 21, 22, 23, reference numerals 10, 12, 14, 16, 20, 30, 32, 330, and 340.

Independent claim 29 is an apparatus claim. The summary of the claimed subject matter for claim 29 is as follows.

The apparatus includes a display. <u>See, for example,</u> the present Application, paragraph [0055], Figure 23, reference numeral 324. The apparatus further includes a pen type input transducer. <u>See, for example,</u> the present Application paragraphs [0029] and [0055], Figure 23, reference numeral 320.

The apparatus further includes a computer coupled to the display and transducer and providing a pan-zoom tracking menu on the display and allowing a user to select and perform pan and zoom operations using the transducer input and moving the menu when an outer edge of the menu is encountered displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated. <u>See, for example,</u> the present Application, paragraphs [0029]-[0034], [0055], Figures 1a, 1b, 2, 3a, 3b, 21, 22, 23, reference numerals 10, 12, 14, 16, 20, 30, 32, 330, and 340.

F. Independent Claim 30

30.   (previously presented) A computer readable storage

controlling a computer via a pan-zoom tracking menu having the appearance of a center and a surrounding ring and interpreting transducer input events as pan and zoom selection and control events and interpreting transducer motion as a menu move event when an outer edge of the menu is encountered the menu is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated.

Support: See, for example, the present Application, paragraphs [0029]-[0034], [0055], [0056], Figures 1a, 1b, 2, 3a, 3b, 21-23, reference numerals 10, 12, 14, 16, 30, 32, 320, 330, 340.

Independent claim 30 is a computer readable storage claim. The summary of the claimed subject matter of claim 30 is as follows.

The computer readable storage includes controlling a computer via a pan-zoom tracking menu having the appearance of a center and a surrounding ring and interpreting transducer input events as pan and zoom selection and control events and interpreting transducer motion as a menu move event when an outer edge of the menu is encountered the menu is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated. See, for example, the present Application, paragraphs [0029]-[0034], [0055], [0056], Figures 1a, 1b, 2, 3a, 3b, 21-23, reference numerals 10, 12, 14, 16, 30, 32, 320, 330, 340.

G. Independent Claim 31

31.   (Currently Amended) A computer readable storage controlling a computer by producing a graphical user interface on a display that has an appearance of a center and a surrounding ring graphic, moving the graphic on the display as a tracking menu responsive to movement of a pen when an outer edge of the surrounding ring graphic is encountered, and interpreting input events initiated by the pen as pan and zoom selection and control events the interface is [[are]]always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated.

Support: See, for example, the present Application, paragraphs [0029]-[0034], [0055], [0056], Figures 1a, 1b, 2, 3a, 3b, 21-23, reference numerals 10, 12, 14, 16, 30, 32, 320, 330, 340.

Independent claim 31 is a computer readable storage claim. The summary of the claimed subject matter of claim 31 is as follows.

The computer readable storage includes controlling a computer by producing a graphical user interface on a display that has an appearance of a center and a surrounding ring graphic,

moving the graphic on the display as a tracking menu responsive to movement of a pen when an outer edge of the surrounding ring graphic is encountered, and interpreting input events initiated by the pen as pan and zoom selection and control events the interface is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated. See, for example, the present Application, paragraphs [0029]-[0034], [0055], [0056], Figures 1a, 1b, 2, 3a, 3b, 21-23, reference numerals 10, 12, 14, 16, 30, 32, 320, 330, 340.

H. Independent Claim 32

32   (currently amended) A graphical user interface displayed on a display, comprising:

a pan-zoom tracking menu having a zoom control in a center and a pan control surrounding the zoom control and with the tracking menu moving when an area immediately outside the menu is about to be reached and the menu is always visible when one of the controls is not activated and always not visible when one of the controls is activated.

Support: See, for example, the present Application, paragraphs [0029]-[0034], Figures 1a, 1b, 2, 3a, 3b, reference numerals 10, 12, 14, 16, 30, 32.

Independent claim 32 recites a graphical user interface display. The summary of the claimed subject matter for claim 32 is as follows.

The interface display includes a pan-zoom tracking menu having a zoom control in a center and a pan control surrounding the zoom control and with the tracking menu moving when an area immediately outside the menu is about to be reached and the menu is always visible when one of the controls is not activated and always not visible when one of the controls is activated. See, for example, the present Application, paragraphs [0029]-[0034], Figures 1a, 1b, 2, 3a, 3b, reference numerals 10, 12, 14, 16, 30, 32.

I. Independent Claim 33

33.   (previously presented) A graphical user interface display displaying an interface, comprising:

Support: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10.

a first region control initiating a first function when activated;

Support: See, for example, the present Application, paragraphs [0029] and [0030], Figures 1a and 1b, reference numeral 14.

a second region control associated with the first region control

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having an outer edge and initiating a second function;

>> *Support*: See, for example, the present Application, paragraphs [0029] and [0031], Figures 1a and 1b, reference numeral 16.

a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge; and

>> *Support*: See, for example, the present Application, paragraphs [0032]-[0033], Figure 2, reference numeral 20.

a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions.

>> *Support*: See, for example, the present Application, paragraphs [0029]-[0033], [0055], Figures 1a, 1b, 2, reference numerals 12, 14, 16, 20, 320.

Independent claim 33 recites a graphical user interface display displaying an interface. See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 10. The summary of the claimed subject matter of claim 33 is as follows.

The interface display includes a first region control initiating a first function when activated. See, for example, the present Application, paragraphs [0029] and [0030], Figures 1a and 1b, reference numeral 14.

The interface display further includes a second region control associated with the first region control having an outer edge and initiating a second function. See, for example, the present Application, paragraphs [0029] and [0031], Figures 1a and 1b, reference numeral 16.

The interface display even further includes a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge. See, for example, the present Application, paragraphs [0032]-[0033], Figure 2, reference numeral 20.

Finally, the interface display includes a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions. See, for example, the present Application, paragraphs [0029]-[0033], [0055], Figures 1a, 1b, 2, reference numerals 12, 14, 16, 20, 320.

J. Dependent Claim 2

2.   (Original) A user interface as recited in claim 1, wherein the second region control surrounds the first region control.

Support: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numerals 14 and 16.

Claim 2 depends from claim 1 and recites wherein the second region control surrounds the first region control. See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numerals 14 and 16.

K. Dependent Claim 3

3.   (Original) A user interface as recited in claim 2, wherein the first region control is circular in shape.

Support: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 14.

Claim 3 depends from claim 2 and recites wherein the first region control is circular in shape. See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numeral 14.

L. Dependent Claim 4

4.   (Original) An interface as recited in claim 1, wherein the second region control is a most frequently used function.

Support: See, for example, the present Application, paragraph [0006], [0054], Figure 20, reference numeral 290.

Dependent claim 4 depends from claim 1 and recites wherein the second region control is a most frequently used function. See, for example, the present Application, paragraph [0006], [0054], Figure 20, reference numeral 290.

M. Dependent Claim 5

5.   (Original) An interface as recited in claim 1, wherein the first function is a zoom function and the second function is a pan function.

Support: See, for example, the present Application, paragraph [0029], reference numerals 14, 16, 18, 19, 20, Figures 1a and 1b.

Dependent claim 5 depends from claim 1 and recites wherein the first function is a zoom function and the second function is a pan function. See, for example, the present Application, paragraph [0029], reference numerals 14, 16, 18, 19, 20, Figures 1a and 1b.

N. Dependent Claim 6

6. (Original) An interface as recited in claim 1, wherein the interface is semi transparent when the functions are not activated, transparent when the functions are activated and one of a zoom and pan icon replaces the tracking symbol when the functions are activated.

Support: See, for example, the present Application, paragraphs [0029], [0034], Figures 1a, 1b, 3a, 3b, reference numeral 10, 12, 14, 16, 18, 19, 20.

Dependent claim 6 depends from claim 1 and recites wherein the interface is semi transparent when the functions are not activated, transparent when the functions are activated and one of a zoom and pan icon replaces the tracking symbol when the functions are activated. See, for example, the present Application, paragraphs [0029], [0034], Figures 1a, 1b, 3a, 3b, reference numeral 10, 12, 14, 16, 18, 19, 20.

O. Dependent Claim 7

7. (Original) An interface as recited in claim 1, wherein the first region control is circular shaped and the second region control is ring shaped.

Support: See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numerals 10, 14, 16.

Dependent claim 7 depends from claim 1 and recites wherein the first region control is circular shaped and the second region control is ring shaped. See, for example, the present Application, paragraph [0029], Figures 1a and 1b, reference numerals 10, 14, 16.

P. Dependent Claim 9

9. (Original) An interface as recited in claim 7, wherein the second region control is segmented into ring segments each being a different control.

Support: See, for example, the present Application, paragraph [0054], Figure 19, reference numerals 274, 276.

Dependent claim 9 depends from claim 7 and recites wherein the second region control is segmented into ring segments each being a different control. See, for example, the present Application, paragraph [0054], Figure 19, reference numerals 274, 276.

Q. Dependent Claim 10

10. (Original) An interface as recited in claim 7, further comprising a ring control having a ring shape surrounding the second control region and initiating a third function when activated.

Support: See, for example, the present Application, paragraph [0054], Figure 19, reference numerals 270, 274, 276,

278.

Dependent claim 10 depends from claim 7 and recites a ring control having a ring shape surrounding the second control region and initiating a third function when activated. See, for example, the present Application, paragraph [0054], Figure 19, reference numerals 270, 274, 276, 278.

R. Dependent Claim 11

> 11.   (Original) An interface as recited in claim 10, further comprising a button control initiating a third function when activated and located on a boundary between the first and second region controls.
>
> > **Support**: See, for example, the present Application, paragraph [0041], Figures 5a and 5b, reference numerals 60, 62, 64, 66, 68.

Dependent claim 11 depends from claim 10 and recites a button control initiating a third function when activated and located on a boundary between the first and second region controls. See, for example, the present Application, paragraph [0041], Figures 5a and 5b, reference numerals 60, 62, 64, 66, 68.

S. Dependent Claim 12

> 12.   (Original) An interface as recited in claim 10, further comprising a button control initiating a third function when activated and located within a region.
>
> > **Support**: See, for example, the present Application, paragraph [0053], Figures 13-18, reference numerals 232, 234, 236, 238.

Dependent claim 12 depends from claim 10 and recites a button control initiating a third function when activated and located within a region. See, for example, the present Application, paragraph [0053], Figures 13-18, reference numerals 232, 234, 236, 238.

T. Dependent Claim 13

> 13.   (previously presented) An interface as recited in claim 1, wherein the interface is transparent when the one of the functions are activated and semitransparent when the functions are not activated.
>
> > **Support**: See, for example, the present Application, paragraphs [0029] and [0034], Figures 1a, 1b, 3a, 3b, reference numerals 10, 14, 16, 30, 32.

Dependent claim 13 depends from claim 1 and recites wherein the interface is transparent when the one of the functions are activated and semitransparent when the functions

are not activated. See, for example, the present Application, paragraphs [0029] and [0034],
Figures 1a, 1b, 3a, 3b, reference numerals 10, 14, 16, 30, 32.

U. Dependent Claim 14

14.   (Original) An interface as recited in claim 1, further
comprising a button control initiating a third function when
activated and located on a boundary between the first and second
region controls.

Support: See, for example, the present Application,
paragraph [0041], Figures 5a and 5b, reference numerals 60, 62,
64, 66, 68.

Dependent claim 14 depends from claim 1 and recites a button control initiating a third
function when activated and located on a boundary between the first and second region
controls. See, for example, the present Application, paragraph [0041], Figures 5a and 5b,
reference numerals 60, 62, 64, 66, 68.

V. Dependent Claim 15

15.   (previously presented) An interface as recited in claim 1,
further comprising button controls initiating a function when
activated and located on a boundary between the first and second
region controls and creating access channels for movement of the
tracking symbol within the interface.

Support: See, for example, the present Application,
paragraph [0042], Figures 5a and 5b, reference numeral 68.

Dependent claim 15 depends from claim 1 and recites button controls initiating a function
when activated and located on a boundary between the first and second region controls and
creating access channels for movement of the tracking symbol within the interface. See, for
example, the present Application, paragraph [0042], Figures 5a and 5b, reference numeral 68.

W. Dependent Claim 16

16.   (Original) An interface as recited in claim 1, wherein the
second region control has an exterior graphic edge and the
tracking boundary coincides with the exterior graphic edge.

Support: See, for example, the present Application,
paragraph [0033], Figure 2, reference numerals 14 and 20.

Dependent claim 16 depends from claim 1 and recites wherein the second region control
has an exterior graphic edge and the tracking boundary coincides with the exterior graphic edge.
See, for example, the present Application, paragraph [0033], Figure 2, reference numerals 14
and 20.

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X. Dependent Claim 17

17.   (Original) An interface as recited in claim 1, wherein the interface is invoked by pressing an activation key.

Support: See, for example, the present Application, paragraph [0057].

Dependent claim 17 depends from claim 1 and recites wherein the interface is invoked by pressing an activation key. See, for example, the present Application, paragraph [0057].

Y. Dependent Claim 18

18.   (Original) An interface as recited in claim 1, wherein the interface is displayed while an activation key is active.

Support: See, for example, the present Application, paragraph [0057].

Dependent claim 18 depends from claim 1 and recites wherein the interface is displayed while an activation key is active. See, for example, the present Application, paragraph [0057].

Z. Dependent Claim 23

23.   (Original) A method as recited in claim 22, displaying a corresponding pan and zoom tracking symbol icon as a replacement for the tool during the performing.

Support: See, for example, the present Application, paragraph [0034], Figures 3a and 3b, reference numerals 30 and 32.

Dependent claim 23 depends from claim 22 and recites displaying a corresponding pan and zoom tracking symbol icon as a replacement for the tool during the performing. See, for example, the present Application, paragraph [0034], Figures 3a and 3b, reference numerals 30 and 32.

AA. Dependent Claim 24

24.   (Original) A method as recited in claim 23, wherein replacement occurs when the tool is pinned.

Support: See, for example, the present Application, paragraph [0045], Figure 6, reference numeral 104.

Dependent claim 24 depends from claim 23 and recites wherein replacement occurs when the tool is pinned. See, for example, the present Application, paragraph [0045], Figure 6, reference numeral 104.

BB. Dependent Claim 25

25.   (Original) A method as recited in claim 22, further

comprising designating a zoom control axis responsive to initial movement of the input transducer after the zoom operation is selected.

> *Support*: See, for example, the present Application, paragraph [0047], Figure 7, reference numeral 130, 132, 134.

Dependent claim 25 depends from claim 22 and recites designating a zoom control axis responsive to initial movement of the input transducer after the zoom operation is selected. See, for example, the present Application, paragraph [0047], Figure 7, reference numeral 130, 132, 134.

CC. Dependent Claim 26

> 26.   (Original) A method as recited in claim 25, further comprising controlling a zoom scale factor responsive to a projection of transducer movements onto the control axis.

> *Support*: See, for example, the present Application, paragraph [0049], Figure 9, reference numeral 164.

Dependent claim 26 depends from claim 25 and recites controlling a zoom scale factor responsive to a projection of transducer movements onto the control axis. See, for example, the present Application, paragraph [0049], Figure 9, reference numeral 164.

DD. Dependent Claim 27

> 27.   (previously presented) A method as recited in claim 22, wherein the tool includes a replaceable control and said method further comprises designating the replaceable control as the most recently selected pan and zoom operation.

> *Support*: See, for example, the present Application, paragraph [0039].

Dependent claim 27 depends from claim 22 and recites wherein the tool includes a replaceable control and said method further comprises designating the replaceable control as the most recently selected pan and zoom operation. See, for example, the present Application, paragraph [0039].

EE. Dependent Claim 28

> 28.   (Original) A method as recited in claim 22, wherein the tool can be pinned and the tool is unpinned when the transducer moves beyond an unpin border.

> *Support*: See, for example, the present Application, paragraph [0046], Figures 5a, 5b, Figure 6, reference numerals 68, 82, 112, 116.

Dependent claim 28 depends from claim 22 and recites wherein the tool can be pinned

and the tool is unpinned when the transducer moves beyond an unpin border. See, for example, the present Application, paragraph [0046], Figures 5a, 5b, Figure 6, reference numerals 68, 82, 112, 116.

FF. Dependent Claim 34

> 34.   (currently amended) A user interface as recited in claim 1, wherein said initiating movement of the interface to track the tracking symbol occurs when the ~~menu~~ interface and controls are not visible.
>
> *Support*: See, for example, the present Application, paragraph [0034], Figures 3a and 3b, reference numerals 12, 30, 32.

Dependent claim 34 depends from claim 1 and recites wherein said initiating movement of the interface to track the tracking symbol occurs when the ~~menu~~ interface and controls are not visible. See, for example, the present Application, paragraph [0034], Figures 3a and 3b, reference numerals 12, 30, 32.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Claims 1-4, 7, 9-12, 14-18, 20-21, 33, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Selker (U.S. Patent Number 6,549,219) in view of Iwema et al. (U.S. Patent Number 7,058,902) further in view of Strauss (U.S. Patent Number 6,246,411).

Claims 5, 22-24, and 28-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Selker in view of Iwema and Strauss, and further in view of Warnock et al. (U.S. Patent Number 5,634,064).

Claims 25-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Selker in view of Iwema, Strauss, and Warnock, and further in view of Mullet et al. (U.S. Patent Number 5,638,523).

Claims 6 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Selker in view of Iwema, Strauss and Warnock, and further in view of Schirmer (U.S. Patent Number 6,369,837) and Beaton et al. (U.S. Patent Number 6,037,937).

VII. ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

A. Review of the Prior Art

1. Selker

Selker discusses a graphical user interface including a plurality of pie menu levels which are concentrically arranged. Further, Selker discusses level 1 comprising a menu item surrounded by another menu item and notes that the level 1 menu item is an item of greater importance, highest popularity based on determined criteria, or highest frequency of use based on a historical analysis. Selker further notes that menu items are selected by direct placement of a mouse cursor over an item followed by a mouse click.

2. Iwema

Iwema discusses a method for selecting actions that can be performed with regard to an object having an associated representation on the display screen of a computer. Further, Iwema discusses displaying context menu choices in the form of icons allowing a user to make menu selections with a stylus.

3. Strauss

Strauss discusses a method for refining the function performed by a drag operation. After a drag operation begins, a "Drag Toolbar" appears with icon or button controls that change the current function of the drag operation when the cursor is moved over a selected control. Strauss further discusses that when the Drag Toolbar is initially displayed, in reasonably close proximity to the cursor, a "follow me" zone defined the found of a region around the Drag Toolbar. If the cursor is within the bounds of the "follow me" zone, the Drag Toolbar does not move, but if the cursor attempts to move past the "follow me" zone boundary, the Drag Toolbar follows the cursor across the user's display.

4. Warnock

Warnock discusses a reader or a method and apparatus for creating, distributing, and displaying electronic documents. Warnock notes that an electronic document is displayed within a window on a computer screen. Further, a tool bar at the top of the screen contains a hand cursor for article scrolling, and two magnifying glass icons.

5. Mullet

Mullet discusses a method and apparatus for browsing through information with a graphical user interface. Further, Mullet discusses a browsing tool which resembles a magnifying glass which appears on top of the information. A user can move the browsing tool across the screen and when a user stops moving the tool, it shows a magnified area of the information inside the boundaries of the tool, and a non-magnified area of the information outside of the tool. The information displayed inside the magnified area is enlarged and additional more detailed information becomes visible. A magnification adjustment slider is adjusted to set the scale of the magnification.

6. Schirmer

Schirmer discusses a method for reducing screen clutter and operator efficiency by improving a control device of a computer display. Schirmer further discusses a group of "rollerballs" used to represent a set of operations. When the rollerballs are not being used, they may be semi-transparent, or low opacity, which minimizes the obstruction to the underlying window. When the rollerballs are activated, the rollerball which is being hovered over, or preselected, increases in size. The preselected rollerball also becomes completely opaque and rollerballs adjacent increase in opacity.

7. Beaton

Beaton discusses graphical control tools for efficient navigation in display devices such as an electronic device with a smaller display area such as an electronic organizer, a PDA, and a portable telephone. The method includes activating the graphical control tools when user input is received. Touch input is ignored unless the navigation control has been activated. Further, the navigation control is preferably transparent and activated by touching and holding the center for a predetermined time period.

B. Rejection of Claims 1-4, 7, 9-12, 14-18, 20-21, 33, and 34 under 35 U.S.C. § 103(a) over Selker, Iwema and Strauss

1. Independent Claim 1

Independent claim 1 recites a graphical user interface display. Further, claim 1 recites a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge of the second control, and the interface and controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated. Claim 1

also recites a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions.

The Office Action mailed December 11, 2008 noted on page 4 that Selker and Iwema do not teach a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the tracking symbol initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol. However, the Office Action on page 4 asserts that Strauss teaches a menu having a menu boundary and comprising a mobile tracking region having a region boundary enclosing the tracking symbol with the tracking symbol being movable within the boundary, the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving. The Office Action improperly quotes claim language from independent claim 1 from related case 10/684,580, concurrently being appealed, and entirely fails to quote language from claim 1 of this present Application. Furthermore, the Office Action cites 'drag toolbar' 40 enclosing cursor 4 and 'follow me' zone 42 of Strauss. The Office Action asserts "when the cursor 4 is within the bounds of the 'follow me' zone 42, the drag toolbar 40 does not move" and "when the cursor 4 moves past the 'follow me' zone boundary, the drag toolbar 40 follows the cursor across the user's display." The Office Action admits on page 5 that Strauss does not expressly teach that the region boundary is coincident with the menu boundary. Once again, the Office Action fails to quote claim language from the present Application, and refers to claim language from related case 10/684,580. Claim 1 of the present Application recites a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge, claim language entirely disregarded by the Office Action.

The Office Action asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented this limitation because Strauss suggests to the skilled artisan that different designs can be applied for the drag toolbar such as the drag toolbar can be in different shapes with different controls" and refers to Figures 2A-4B of Strauss and column 4, lines 24-54. Furthermore, the Office Action asserts that "[o]ne would be motivated to implement this feature [is] to provide a user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently."

Strauss notes that "[a]fter a drag operation begins, a 'Drag Toolbar' appears with an icon

or button controls that change the current function of the drag operation when the cursor is moved over a selected control." That is, the controls are always visible so that the function can be selected by moving over the desired control. Further, "the Drag Toolbar may be floating and have a "follow me" characteristic, where the Drag Toolbar moves so as to always be within a certain distance from the cursor, for the convenience of close access." Strauss discusses that "[o]ne of the principal advantages of the invention is that it provides an unambiguous way for a user to change the drag functionality of a cursor during a drag operation. Thus, a user need not memorize different keyboard modifier combinations, as in the prior art. Further, the graphical user interface is not cluttered, since the Drag Toolbar only appears when a drag operation is initiated." (See Strauss, column 2, lines 20-23, 44-48, 49-55). Thus, Strauss requires that to operate a control during a drag operation the control must be visible.

Column 6, lines 59-67 of Strauss specifically discusses that "shown in Fig. 7, a Drag Toolbar 40 is initially displayed in reasonably close proximity to the cursor, but has a "follow me" zone 42 which defines the bounds of a region around the Drag Toolbar 40. If the cursor is within the bounds of the "follow me" zone, the Drag Toolbar 40 does not move. However, if the cursor 4 attempts to move past the 'follow me' zone boundary, the Drag Toolbar 40 follows the cursor across the user's display." If Strauss were to modified as asserted by the Examiner to make the "follow me" boundary and "Drag Toolbar" boundaries coincident, if a user of Strauss were to start a drag event, and desire to change functionality by moving into the "Drag Toolbar" which would also be the "Follow Me" area during the drag, as the user tried to leave the "Drag Toolbar" after changing functionality, the "Drag Toolbar" would continue to follow the user's cursor and the user would then be trapped in the "Drag Toolbar" and not be able to leave the "Drag Toolbar" area.

Strauss specifically notes in column 3, line 66-column 4, line 10 that a user changes functionality (i.e. a COPY to a MOVE) during a drag by merely moving the cursor "over" a button in the drag toolbar, or clicking a different mouse button or releasing the currently depressed mouse button and pressing it again. Because the Drag Toolbar is displayed during the on going drag operation while the mouse button is depressed the user could also likely make unintended selections of other functions in the Drag Toolbar because the "Follow Me" zone boundary and 'Drag Toolbar' area would be made coincident. As the Drag Toolbar continues to stay very close to the mouse cursor, simply mousing over buttons in the Drag Toolbar, which inevitably would occur, would cause the functionality to flip-flop between MOVE and COPY, for example. Additionally, if the user does not move inside the coincident "Drag Toolbar" & "Follow me" boundaries, as the user moves away from the "Drag Toolbar," the Drag Toolbar would not be able to follow the user's cursor across the display and would simply stay stationary.

This is why Strauss specifically teaches away from the claims by teaching that the Drag Toolbar has a separate and distant "follow me" zone 42 which is different from the boundary and far outside of the 'Drag Toolbar' actually discussed by Strauss.

Thus, "follow me" zone boundary of Strauss must be a particular distance away from the "Drag Toolbar" and cursor as shown in Figure 7. A modification to Strauss as suggested by the Examiner would actually make the Drag Toolbar less efficient to use, rather than more efficient, and inoperable for its intended function. Thus, one of ordinary skill in the art at the time of the invention would not have been motivated to make such a change to Strauss, and such a change certainly would not be obvious.

The above discussion will be made clearer by the Board interacting with a demonstration software program (StraussController.exe) and viewing a short demonstrational movie (StraussDrag.mov) both of which were submitted with the Applicant's response on a compact disc on September 15, 2008 and will be shown during the Applicant's oral argument with the permission of the Board. As it is much easier to see how this modification of Strauss would render its teaching unusable, the demo and movie clearly indicate why one of ordinary skill in the art at the time of the invention would not have been motivated to make the Drag Toolbar and Follow Me boundaries coincident.

In particular, the video illustrates performing a dragging task with the tracking menus of the claims of this Application as well as Strauss controllers as modified by the assertion of the Office Action.

The first scene in the video (tracking menu of Claim 1) shows that a menu having a boundary where the menu follows the cursor until a color is selected by the mouse button being depressed where the menu disappears and the user is allowed to draw a purple line. As soon as the mouse button is no longer depressed, the menu reappears and continues to follow the cursor if the cursor tries to move outside the boundary.

The second scene shows Strauss without a Follow Me boundary and unmodified by the comments in the Office Action made by the Examiner. When a user depresses a mouse button and begins to drag, the Drag Toolbar appears and a user can make a selection by moving the cursor over a button in the Drag Toolbar.

The third scene of the video shows Strauss with the "distant" Follow Me boundary as discussed in Strauss but without the modification of the Office Action asserted by the Examiner. When a user depresses a mouse button and begins to drag, the Drag Toolbar appears and a user may make a selection by moving the cursor over one of the buttons in the Drag Toolbar.

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When the user reaches the Follow Me boundary, the Drag Toolbar begins to follow the cursor during the drag operation, causing an unintended selection of other buttons in the Drag Toolbar.

The fourth and final scene in the video shows Strauss as modified by the hindsight Office Action comments so that the Follow Me boundary is coincident with the Drag Toolbar. Once the user depresses a mouse button and begins to drag, the Drag Toolbar appears. If the user moves the cursor over one of the buttons in the Drag Toolbar, the current function changes. Because the Follow Me boundary is coincident with the Drag Toolbar, as the user continues to move the mouse away during the drag, the Drag Toolbar follows the cursor, causing unintended continual changes in the current functionality.

Additionally, although not shown, if the user never entered the coincident follow me Drag Toolbar boundaries, the Drag Toolbar would not follow the cursor at all.

In conclusion, while Strauss's menu is not displayed until the mouse is depressed, this is opposite of the claims of this Application, and the modification of the Follow Me toolbar, according to the hindsight Office Action comments results in the constant unintended changes of the current function.

The software demonstration allows members of the Board to try both an example of the distinctive features of the claims of this Application as well as the hindsight modified version of Strauss as shown in the video discussed above.

The Examiner, on page 16 of the Office Action mailed December 11, 2008 has asserted that "it would have been obvious to a person of ordinary skill in the art **to try** to match the region boundary with the menu boundary in an attempt to provide an end user with a visual cue as to what the tracking boundary is, [so] that the end user can use the menu more efficiently." Not only has the Office Action incorrectly quoted claim language from claim 1 of related case 10/684,580, but the Office Action made an identical spelling error.

In light of the discussion above, video and demonstration, if one did try to make both the follow me and drag toolbar boundaries coincident, one would realize that this would make Strauss's Drag Toolbar unusable. Although the Supreme Court has recently indicated that an "obvious to try" rationale is permissible in an obviousness rejection, the Office Action's rationale is an improper "obvious to try" rationale, as such a "try" clearly would make Strauss's Drag Toolbar nearly impossible to use. (See MPEP, 2145 and *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007)). Thus, even if one of ordinary skill were to try such a modification, the modification would not be successful.

As noted in MPEP 2143.01,"if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, by making the "Drag Toolbar" and follow me boundaries coincident, this would effectively render Strauss unsatisfactory for its intended purpose of providing the "Drag Toolbar" "so as always to be within a certain distance from the cursor." Either the "Drag Toolbar" would stay continually with the cursor once the cursor enters the "Drag Toolbar" rather than stay a specified distance from the cursor, or fail to follow the cursor at all if modified as asserted by the Examiner.

In light of the above discussion, Examiner has failed to establish a *prima facie* case of obviousness because nothing cited or found in Iwema and Strauss, as modified by the Examiner's assertion, taken alone and in combination teaches "a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the interface" and "initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol."

Furthermore, nothing cited or found in Iwema teaches "the interface and controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated." Strauss also clearly does not teach this feature, because Strauss's Drag Toolbar only appears during a drag operation, and thus is visible when activated. Additionally, Selker also does not teach this feature.

The Office Action, on page 2, refers to column 5, lines 46-61 of Selker, which discusses nothing about the above claim features. Furthermore, Iwema, in column 11, lines 5-12 merely discusses that "whenever a user makes a menu choice that does not have an associated lower level menu, the menu having that choice disappears, but all higher level menus remain." Thus Iwema does not teach "the interface and controls are always visible when one of the controls is not activated and always visible when one of the controls is activated." Iwema merely discusses that a menu closes when a menu choice does not have a lower menu, which is unrelated to the above claim features.

Thus, independent claim 1 patentably distinguishes over Selker, Iwema, and Strauss, taken alone and in combination.

2. Independent Claim 20

Independent claim 20 recites a user interface display. Further, claim 20 recites a tracking

symbol movable within the control and moving the control when the exterior edge of the peripheral region is encountered and the control is always visible when one of the functions is not activated and always not visible when one of the functions is activated.

The Office Action mailed December 11, 2008 noted on page 6 that claim 20 is rejected based on the same hindsight rationale as claim 1.

Claim 20 emphasizes the features of "a tracking symbol movable within the control and moving the control when the exterior edge of the peripheral region is encountered and the control is always visible when one of the functions is not activated and always not visible when one of the functions is activated" found in claim 1 and emphasizes a further additionally distinguishing feature. In particular, claim 20 recites "a movable control having a first function activatable in an entire peripheral region of the control and a second function activatable in a central region of the control having an exterior edge." Claim 1 does not recite "a first function activatable in an entire peripheral region of the control and a second function activatable in a central region of the control having an exterior edge." Therefore, it was improper for claim 20 to be rejected along the same rationale as in claim 1, because claim 20 recites additional features which were not addressed by the Office Action. Nothing cited or found in Selker, Iwema, and Strauss teaches an entire peripheral region and a central region of the control having an exterior edge as recited in claim 20.

Thus, claim 20 patentably distinguishes over Selker, Iwema, and Strauss.

3. Independent Claim 21

Independent claim 21 recites a user interface display. Further, claim 21 recites a tracking menu having a first function activatable in an entire peripheral region of the menu and having an exterior edge, a second function activatable in a central region of the menu and a tracking symbol tracking a position of a user positionable input transducer and causing the menu tool to move when the exterior edge is encountered and the menu is always visible when one of the functions is not activated and always not visible when one of the functions is activated.

The Office Action mailed December 11, 2008 noted on page 6 that "claim 21 is in the same context as claim 20; therefore it is rejected under similar rationale."

Claim 21 emphasizes the features of "a tracking symbol tracking a position of a user positionable input transducer and causing the menu tool to move when the exterior edge is encountered and the menu is always visible when one of the functions is not activated and always not visible when one of the functions is activated" which are similar to features found in

claim 1 and also emphasizes a further additionally distinguishing feature.

In particular, claim 21 recites "a tracking symbol tracking a position of a user positionable input transducer" which is not recited by claim 20. Therefore, it was improper for claim 21 to be rejected along the same rationale as in claim 20, because claim 21 recites additional features which were not addressed by the Office Action.

Thus, claim 21 patentably distinguishes over Selker, Iwema, and Strauss.

4. Independent Claim 33

Independent claim 33 recites a graphical user interface displaying an interface. Further, claim 33 recites "a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge" and "a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol."

Claim 33 emphasizes the features of "a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge" and "initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol" found in claim 1.

Thus, claim 33 patentably distinguishes over Selker, Iwema, and Strauss.

5. Dependent Claim 2

Dependent claim 2 is at least patentable due to its dependency from independent claim 1.

6. Dependent Claim 3

Dependent claim 3 is at least patentable due to its dependency from independent claim 1.

7. Dependent Claim 4

Dependent claim 4 is at least patentable due to its dependency from independent claim 1. Dependent claim 4 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. In particular, although the Office Action on page 6 asserts that Selker in column 4, lines 62-67 and column 5, lines 1-3, teaches "wherein the second region control is a most

frequently used function," Selker is unrelated to a most frequently used function. Nothing cited in these lines of Selker discusses a most frequently used function. It is submitted that claim 4 is independently patentable over Selker, Iwema, and Strauss.

8. Dependent Claim 7

Dependent claim 7 is at least patentable due to its dependency from independent claim 1.

9. Dependent Claim 9

Dependent claim 9 is at least patentable due to its dependency from independent claim 1.

10. Dependent Claim 10

Dependent claim 10 is at least patentable due to its dependency from independent claim 1.

11. Dependent Claim 11

Dependent claim 11 is at least patentable due to its dependency from independent claim 1. Dependent claim 11 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. The Office Action, on page 7, asserts that claim 11 is taught by Figure 6 of Selker. However, Figure 6 of Selker does not show "a button control initiating a third function when activated and located on a boundary between the first and second region controls." Selker does not show or discuss a button on a boundary between the first and second region controls.

12. Dependent Claim 12

Dependent claim 12 is at least patentable due to its dependency from independent claim 1.

13. Dependent Claim 14

Dependent claim 14 is at least patentable due to its dependency from independent claim 1. Dependent claim 14 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. The Office Action, on page 7, asserts that claim 14, like claim 11, is taught by Figure 6 of Selker. However, Figure 6 of Selker does not show "a button control initiating a third function when activated and located on a boundary between the first and second region controls." Selker does not show or discuss a button on a boundary between the first and second region controls.

14. Dependent Claim 15

Dependent claim 15 is at least patentable due to its dependency from independent claim 1. Dependent claim 15 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. The Office Action, on page 7, asserts that Selker teaches "creating access channels for movement of the tracking symbol within the interface." However, as shown in Figures 11a and 11b of the Application, 196 and 198, Selker does not show creating access channels. Moving within the ring region 61 and 62 is not "creating access channels for movement of the tracking symbol within the interface."

15. Dependent Claim 16

Dependent claim 16 is at least patentable due to its dependency from independent claim 1. Dependent claim 16 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. Claim 16 patentably distinguishes over Selker, Iwema, and Strauss, because as discussed above, Strauss cannot be modified as asserted by the hindsight comments of the Office Action so that "the tracking boundary coincides with the exterior graphic edge."

16. Dependent Claim 17

Dependent claim 17 is at least patentable due to its dependency from independent claim 1. Dependent claim 17 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. In particular, claim 17 recites "wherein the interface is invoked by pressing an activation key." It is respectfully submitted that Strauss, in column 2, lines 54-55 does not discuss "an activation key," but merely notes that the Drag Toolbar appears when a drag operation is initiated.

17. Dependent Claim 18

Dependent claim 18 is at least patentable due to its dependency from independent claim 1. Dependent claim 18 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. In particular, claim 18 recites "the interface is displayed while an activation key is active." Although the Office Action, on page 8, asserts that Strauss, column 2, lines 54-55 teach the above claim features, Strauss merely notes that the Drag Toolbar appears when a drag operation is initiated. Nothing in Strauss discusses an activation key.

18. Dependent Claim 34

Dependent claim 34 is at least patentable due to its dependency from independent claim

33. Dependent claim 34 also recites additional features not taught or suggested by Selker, Iwema, and Strauss. In particular, nothing cited or found in Iwema discusses "said initiating movement of the interface to track the tracking symbol occurs when the interface and controls are not visible." The Office Action, on page 8, asserts that Iwema teaches in Figures 3 and 9 that "the context menu is moved corresponding to the pointer device while the menu is not visible." However, Iwema cannot be combined with Strauss because as discussed above, the Drag Toolbar of Strauss only appears during a dragging operation, and does not follow the cursor otherwise, and thus Iwema and Strauss do not teach "track the tracking symbol occurs when the interface and controls are not visible."

C. Rejection of Claims 5, 22-24, and 28-32 under 35 U.S.C. § 103(a) over Selker, Iwema, Strauss and Warnock

1. Independent Claim 22

Independent claim 22 recites a method. Further, claim 22 recites performing a selected one of the pan and zoom operation responsive to movements of the input transducer by the user and causing the menu to move when the exterior edge is encountered and presenting the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated.

The Office Action, on page 9, asserts that independent claim 22 is taught for the same reasons provided for independent claim 1 and also refers to Selker, column 5, lines 47-61.

The Office Action mailed December 11, 2008 noted on page 4 that Selker and Iwema do not teach a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the tracking symbol initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol. However, the Office Action on page 4 asserts that Strauss teaches a menu having a menu boundary and comprising a mobile tracking region having a region boundary enclosing the tracking symbol with the tracking symbol being movable within the boundary, the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving. Furthermore, the Office Action cites 'drag toolbar' 40 enclosing cursor 4 and 'follow me' zone 42 of Strauss. The Office Action asserts "when the cursor 4 is within the bounds of the 'follow me' zone 42, the drag toolbar 40 does not move" and "when the cursor 4 moves past the 'follow me' zone boundary, the drag toolbar 40 follows the cursor across the user's display." The Office Action admits on page 5 that Strauss does not expressly teach that the region boundary is coincident with the menu boundary.

The Office Action asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented this limitation because Strauss suggests to the skilled artisan that different designs can be applied for the drag toolbar such as the drag toolbar can be in different shapes with different controls" and refers to Figures 2A-4B of Strauss and column 4, lines 24-54. Furthermore, the Office Action asserts that "[o]ne would be motivated to implement this feature [is] to provide a user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently."

Strauss notes that "[a]fter a drag operation begins, a 'Drag Toolbar' appears with an icon or button controls that change the current function of the drag operation when the cursor is moved over a selected control." That is, the controls are always visible so that the function can be selected by moving over the desired control. Further, "the Drag Toolbar may be floating and have a "follow me" characteristic, where the Drag Toolbar moves so as to always be within a certain distance from the cursor, for the convenience of close access." Strauss discusses that "[o]ne of the principal advantages of the invention is that it provides an unambiguous way for a user to change the drag functionality of a cursor during a drag operation. Thus, a user need not memorize different keyboard modifier combinations, as in the prior art. Further, the graphical user interface is not cluttered, since the Drag Toolbar only appears when a drag operation is initiated." (See Strauss, column 2, lines 20-23, 44-48, 49-55). Thus, Strauss requires that to operate a control during a drag operation the control must be visible.

Column 6, lines 59-67 of Strauss specifically discusses that "shown in Fig. 7, a Drag Toolbar 40 is initially displayed in reasonably close proximity to the cursor, but has a "follow me" zone 42 which defines the bounds of a region around the Drag Toolbar 40. If the cursor is within the bounds of the "follow me" zone, the Drag Toolbar 40 does not move. However, if the cursor 4 attempts to move past the 'follow me' zone boundary, the Drag Toolbar 40 follows the cursor across the user's display." If Strauss were to modified as asserted by the Examiner to make the "follow me" boundary and "Drag Toolbar" boundaries coincident, if a user of Strauss were to start a drag event, and desire to change functionality by moving into the "Drag Toolbar" which would also be the "Follow Me" area during the drag, as the user tried to leave the "Drag Toolbar" after changing functionality, the "Drag Toolbar" would continue to follow the user's cursor and the user would then be trapped in the "Drag Toolbar" and not be able to leave the "Drag Toolbar" area.

Strauss specifically notes in column 3, line 66-column 4, line 10 that a user changes functionality (i.e. a COPY to a MOVE) during a drag by merely moving the cursor "over" a button in the drag toolbar, or clicking a different mouse button or releasing the currently depressed

mouse button and pressing it again. Because the Drag Toolbar is displayed during the on going drag operation while the mouse button is depressed the user could also likely make unintended selections of other functions in the Drag Toolbar because the "Follow Me" zone boundary and 'Drag Toolbar' area would be made coincident. As the Drag Toolbar continues to stay very close to the mouse cursor, simply mousing over buttons in the Drag Toolbar, which inevitably would occur, would cause the functionality to flip-flop between MOVE and COPY, for example. Additionally, if the user does not move inside the coincident "Drag Toolbar" & "Follow me" boundaries, as the user moves away from the "Drag Toolbar," the Drag Toolbar would not be able to follow the user's cursor across the display and would simply stay stationary.

This is why Strauss specifically teaches away from the claims by teaching that the Drag Toolbar has a separate and distant "follow me" zone 42 which is different from the boundary and far outside of the 'Drag Toolbar' actually discussed by Strauss.

Thus, "follow me" zone boundary of Strauss must be a particular distance away from the "Drag Toolbar" and cursor as shown in Figure 7. A modification to Strauss as suggested by the Examiner would actually make the Drag Toolbar less efficient to use, rather than more efficient, and inoperable for its intended function. Thus, one of ordinary skill in the art at the time of the invention would not have been motivated to make such a change to Strauss, and such a change certainly would not be obvious.

The Examiner, on page 16 of the Office Action mailed December 11, 2008 has asserted that "it would have been obvious to a person of ordinary skill in the art **to try** to match the region boundary with the menu boundary in an attempt to provide an end user with a visual cue as to what the tracking boundary is, [so] that the end user can use the menu more efficiently."

In light of the discussion above, if one did try to make both the follow me and drag toolbar boundaries coincident, one would realize that this would make Strauss's Drag Toolbar unusable. Although the Supreme Court has recently indicated that an "obvious to try" rationale is permissible in an obviousness rejection, the Office Action's rationale is an improper "obvious to try" rationale, as such a "try" clearly would make Strauss's Drag Toolbar nearly impossible to use. (See MPEP, 2145 and *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007)). Thus, even if one of ordinary skill were to try such a modification, the modification would not be successful.

As noted in MPEP 2143.01,"if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir.

1984). As discussed above, by making the "Drag Toolbar" and follow me boundaries coincident, this would effectively render Strauss unsatisfactory for its intended purpose of providing the "Drag Toolbar" "so as always to be within a certain distance from the cursor." Either the "Drag Toolbar" would stay continually with the cursor once the cursor enters the "Drag Toolbar" rather than stay a specified distance from the cursor, or fail to follow the cursor at all if modified as asserted by the Examiner.

In light of the above discussion, Examiner has failed to establish a *prima facie* case of obviousness because nothing cited or found in Iwema and Strauss, as modified by the Examiner's assertion, taken alone and in combination teaches "displaying a pan-zoom tracking menu tool having an exterior edge" and "performing a selected one of the pan and zoom operation responsive to movements of the input transducer by the user and causing the menu to move when the exterior edge is encountered."

Furthermore, nothing cited or found in Iwema teaches "presenting the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated." Strauss also clearly does not teach this feature, because Strauss's Drag Toolbar only appears during a drag operation, and thus is visible when activated. Additionally, Selker also does not teach this feature.

The Office Action, on page 9, refers to column 5, lines 47-61 of Selker, which discusses nothing about the above claim features. Furthermore, Iwema, in column 11, lines 5-12 merely discusses that "whenever a user makes a menu choice that does not have an associated lower level menu, the menu having that choice disappears, but all higher level menus remain." Thus Iwema does not teach "presenting the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated." Iwema merely discusses that a menu closes when a menu choice does not have a lower menu, which is unrelated to the above claim features.

Claim 22 emphasizes the features of causing the menu to move when the exterior edge is encountered and presenting the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated, similar to the features found in independent claim 1 and emphasizes other distinguishing features.

In particular, the Office Action on page 9 admits that Selker, Iwema, and Strauss do not expressly teach that the tracking menu includes pan and zoom operations. The Office Action then asserts that Warnock cures the deficiencies of Selker, Iwema, and Strauss in column 10, lines 20-35 and Figure 4a. Warnock discusses a non-movable tool bar in Adobe Acrobat which

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can be used to zoom in and out of an electronic document. Nothing in Warnock discusses pan operations and the Office Action does not indicate how Warnock would be modified so that zoom and pan buttons would be part of a menu movable when the exterior edge is encountered.

Thus, independent claim 22 patentably distinguishes over Selker, Iwema, Strauss, and Warnock.

2. Independent Claim 29

Independent claim 29 recites an apparatus. Further, claim 29 recites moving the menu when an outer edge of the menu is encountered displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated.

The Office Action, on page 9, asserts that "claim 29 reflects an apparatus comprising a display and a pen type input transducer for performing the method steps as recited in claim 22, and is rejected along the same rationale."

Referring to the rejection of claim 22, which in turn refers to the rejection of claim 1, the Office Action mailed December 11, 2008 noted on page 4 that Selker and Iwema do not teach a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the tracking symbol initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol. However, the Office Action on page 4 asserts that Strauss teaches a menu having a menu boundary and comprising a mobile tracking region having a region boundary enclosing the tracking symbol with the tracking symbol being movable within the boundary, the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving. Furthermore, the Office Action cites 'drag toolbar' 40 enclosing cursor 4 and 'follow me' zone 42 of Strauss. The Office Action asserts "when the cursor 4 is within the bounds of the 'follow me' zone 42, the drag toolbar 40 does not move" and "when the cursor 4 moves past the 'follow me' zone boundary, the drag toolbar 40 follows the cursor across the user's display." The Office Action admits on page 5 that Strauss does not expressly teach that the region boundary is coincident with the menu boundary.

The Office Action asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented this limitation because Strauss suggests to the skilled artisan that different designs can be applied for the drag toolbar such as the drag toolbar can be in different shapes with different controls" and refers to Figures 2A-4B of Strauss and column 4, lines 24-54. Furthermore, the Office Action asserts that "[o]ne would be

motivated to implement this feature [is] to provide a user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently."

Strauss notes that "[a]fter a drag operation begins, a 'Drag Toolbar' appears with an icon or button controls that change the current function of the drag operation when the cursor is moved over a selected control." That is, the controls are always visible so that the function can be selected by moving over the desired control. Further, "the Drag Toolbar may be floating and have a "follow me" characteristic, where the Drag Toolbar moves so as to always be within a certain distance from the cursor, for the convenience of close access." Strauss discusses that "[o]ne of the principal advantages of the invention is that it provides an unambiguous way for a user to change the drag functionality of a cursor during a drag operation. Thus, a user need not memorize different keyboard modifier combinations, as in the prior art. Further, the graphical user interface is not cluttered, since the Drag Toolbar only appears when a drag operation is initiated." (See Strauss, column 2, lines 20-23, 44-48, 49-55). Thus, Strauss requires that to operate a control during a drag operation the control must be visible.

Column 6, lines 59-67 of Strauss specifically discusses that "shown in Fig. 7, a Drag Toolbar 40 is initially displayed in reasonably close proximity to the cursor, but has a "follow me" zone 42 which defines the bounds of a region around the Drag Toolbar 40. If the cursor is within the bounds of the "follow me" zone, the Drag Toolbar 40 does not move. However, if the cursor 4 attempts to move past the 'follow me' zone boundary, the Drag Toolbar 40 follows the cursor across the user's display." If Strauss were to modified as asserted by the Examiner to make the "follow me" boundary and "Drag Toolbar" boundaries coincident, if a user of Strauss were to start a drag event, and desire to change functionality by moving into the "Drag Toolbar" which would also be the "Follow Me" area during the drag, as the user tried to leave the "Drag Toolbar" after changing functionality, the "Drag Toolbar" would continue to follow the user's cursor and the user would then be trapped in the "Drag Toolbar" and not be able to leave the "Drag Toolbar" area.

Strauss specifically notes in column 3, line 66-column 4, line 10 that a user changes functionality (i.e. a COPY to a MOVE) during a drag by merely moving the cursor "over" a button in the drag toolbar, or clicking a different mouse button or releasing the currently depressed mouse button and pressing it again. Because the Drag Toolbar is displayed during the on going drag operation while the mouse button is depressed the user could also likely make unintended selections of other functions in the Drag Toolbar because the "Follow Me" zone boundary and 'Drag Toolbar' area would be made coincident. As the Drag Toolbar continues to stay very close to the mouse cursor, simply mousing over buttons in the Drag Toolbar, which inevitably would

occur, would cause the functionality to flip-flop between MOVE and COPY, for example. Additionally, if the user does not move inside the coincident "Drag Toolbar" & "Follow me" boundaries, as the user moves away from the "Drag Toolbar," the Drag Toolbar would not be able to follow the user's cursor across the display and would simply stay stationary.

This is why Strauss specifically teaches away from the claims by teaching that the Drag Toolbar has a separate and distant "follow me" zone 42 which is different from the boundary and far outside of the 'Drag Toolbar' actually discussed by Strauss.

Thus, "follow me" zone boundary of Strauss must be a particular distance away from the "Drag Toolbar" and cursor as shown in Figure 7. A modification to Strauss as suggested by the Examiner would actually make the Drag Toolbar less efficient to use, rather than more efficient, and inoperable for its intended function. Thus, one of ordinary skill in the art at the time of the invention would not have been motivated to make such a change to Strauss, and such a change certainly would not be obvious.

The Examiner, on page 16 of the Office Action mailed December 11, 2008 has asserted that "it would have been obvious to a person of ordinary skill in the art **to try** to match the region boundary with the menu boundary in an attempt to provide an end user with a visual cue as to what the tracking boundary is, [so] that the end user can use the menu more efficiently."

In light of the discussion above, if one did try to make both the follow me and drag toolbar boundaries coincident, one would realize that this would make Strauss's Drag Toolbar unusable. Although the Supreme Court has recently indicated that an "obvious to try" rationale is permissible in an obviousness rejection, the Office Action's rationale is an improper "obvious to try" rationale, as such a "try" clearly would make Strauss's Drag Toolbar nearly impossible to use. (See MPEP, 2145 and *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007)). Thus, even if one of ordinary skill were to try such a modification, the modification would not be successful.

As noted in MPEP 2143.01,"if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, by making the "Drag Toolbar" and follow me boundaries coincident, this would effectively render Strauss unsatisfactory for its intended purpose of providing the "Drag Toolbar" "so as always to be within a certain distance from the cursor." Either the "Drag Toolbar" would stay continually with the cursor once the cursor enters the "Drag Toolbar" rather than stay a specified distance from the cursor, or fail to follow the cursor at all if modified as

asserted by the Examiner.

In light of the above discussion, Examiner has failed to establish a *prima facie* case of obviousness because nothing cited or found in Iwema and Strauss, as modified by the Examiner's assertion, taken alone and in combination teaches "moving the menu when an outer edge of the menu is encountered."

Furthermore, nothing cited or found in Iwema teaches "displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated." Strauss also clearly does not teach this feature, because Strauss's Drag Toolbar only appears during a drag operation, and thus is visible when activated. Additionally, Selker also does not teach this feature.

The Office Action, on page 9, refers to column 5, lines 47-61 of Selker, which discusses nothing about the above claim features. Furthermore, Iwema, in column 11, lines 5-12 merely discusses that "whenever a user makes a menu choice that does not have an associated lower level menu, the menu having that choice disappears, but all higher level menus remain." Thus Iwema does not teach "displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated." Iwema merely discusses that a menu closes when a menu choice does not have a lower menu, which is unrelated to the above claim features.

Claim 29 emphasizes the features of "moving the menu when an outer edge of the menu is encountered" and "displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated" found in claim 1 and emphasizes and further additionally distinguishing feature.

In particular, claim 29 provides a pan-zoom tracking menu that moves when an outer edge of the menu is encountered. Nothing cited or found in Warnock discusses a pan-zoom tracking menu that can move, rather, Warnock merely discusses a stationary toolbar.

Thus, independent claim 29 patentably distinguishes over Selker, Iwema, Strauss, and Warnock.

3. Independent Claim 30

Independent claim 30 recites a computer readable storage controlling a computer. Further, claim 30 recites interpreting transducer motion as a menu move event when an outer edge of the menu is encountered the menu is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events

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indicates pan or zoom is activated.

The Office Action, on pages 10 and 11, in its rejection of claim 30, notes "see the discussion of claim 1 as set forth above." The rejection of claim 30 also refers to the rejection of claim 22.

The Office Action mailed December 11, 2008 noted on page 4 that Selker and Iwema do not teach a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the tracking symbol initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol. However, the Office Action on page 4 asserts that Strauss teaches a menu having a menu boundary and comprising a mobile tracking region having a region boundary enclosing the tracking symbol with the tracking symbol being movable within the boundary, the region moving in correspondence to the tracking symbol when the tracking symbol encounters the boundary while moving. Furthermore, the Office Action cites 'drag toolbar' 40 enclosing cursor 4 and 'follow me' zone 42 of Strauss. The Office Action asserts "when the cursor 4 is within the bounds of the 'follow me' zone 42, the drag toolbar 40 does not move" and "when the cursor 4 moves past the 'follow me' zone boundary, the drag toolbar 40 follows the cursor across the user's display." The Office Action admits on page 5 that Strauss does not expressly teach that the region boundary is coincident with the menu boundary.

The Office Action asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented this limitation because Strauss suggests to the skilled artisan that different designs can be applied for the drag toolbar such as the drag toolbar can be in different shapes with different controls" and refers to Figures 2A-4B of Strauss and column 4, lines 24-54. Furthermore, the Office Action asserts that "[o]ne would be motivated to implement this feature [is] to provide a user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently."

Strauss notes that "[a]fter a drag operation begins, a 'Drag Toolbar' appears with an icon or button controls that change the current function of the drag operation when the cursor is moved over a selected control." That is, the controls are always visible so that the function can be selected by moving over the desired control. Further, "the Drag Toolbar may be floating and have a "follow me" characteristic, where the Drag Toolbar moves so as to always be within a certain distance from the cursor, for the convenience of close access." Strauss discusses that "[o]ne of the principal advantages of the invention is that it provides an unambiguous way for a user to change the drag functionality of a cursor during a drag operation. Thus, a user need not

memorize different keyboard modifier combinations, as in the prior art. Further, the graphical user interface is not cluttered, since the Drag Toolbar only appears when a drag operation is initiated." (See Strauss, column 2, lines 20-23, 44-48, 49-55). Thus, Strauss requires that to operate a control during a drag operation the control must be visible.

Column 6, lines 59-67 of Strauss specifically discusses that "shown in Fig. 7, a Drag Toolbar 40 is initially displayed in reasonably close proximity to the cursor, but has a "follow me" zone 42 which defines the bounds of a region around the Drag Toolbar 40. If the cursor is within the bounds of the "follow me" zone, the Drag Toolbar 40 does not move. However, if the cursor 4 attempts to move past the 'follow me' zone boundary, the Drag Toolbar 40 follows the cursor across the user's display." If Strauss were to modified as asserted by the Examiner to make the "follow me" boundary and "Drag Toolbar" boundaries coincident, if a user of Strauss were to start a drag event, and desire to change functionality by moving into the "Drag Toolbar" which would also be the "Follow Me" area during the drag, as the user tried to leave the "Drag Toolbar" after changing functionality, the "Drag Toolbar" would continue to follow the user's cursor and the user would then be trapped in the "Drag Toolbar" and not be able to leave the "Drag Toolbar" area.

Strauss specifically notes in column 3, line 66-column 4, line 10 that a user changes functionality (i.e. a COPY to a MOVE) during a drag by merely moving the cursor "over" a button in the drag toolbar, or clicking a different mouse button or releasing the currently depressed mouse button and pressing it again. Because the Drag Toolbar is displayed during the on going drag operation while the mouse button is depressed the user could also likely make unintended selections of other functions in the Drag Toolbar because the "Follow Me" zone boundary and 'Drag Toolbar' area would be made coincident. As the Drag Toolbar continues to stay very close to the mouse cursor, simply mousing over buttons in the Drag Toolbar, which inevitably would occur, would cause the functionality to flip-flop between MOVE and COPY, for example. Additionally, if the user does not move inside the coincident "Drag Toolbar" & "Follow me" boundaries, as the user moves away from the "Drag Toolbar," the Drag Toolbar would not be able to follow the user's cursor across the display and would simply stay stationary.

This is why Strauss specifically teaches away from the claims by teaching that the Drag Toolbar has a separate and distant "follow me" zone 42 which is different from the boundary and far outside of the 'Drag Toolbar' actually discussed by Strauss.

Thus, "follow me" zone boundary of Strauss must be a particular distance away from the "Drag Toolbar" and cursor as shown in Figure 7. A modification to Strauss as suggested by the Examiner would actually make the Drag Toolbar less efficient to use, rather than more efficient,

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and inoperable for its intended function. Thus, one of ordinary skill in the art at the time of the invention would not have been motivated to make such a change to Strauss, and such a change certainly would not be obvious.

The Examiner, on page 16 of the Office Action mailed December 11, 2008 has asserted that "it would have been obvious to a person of ordinary skill in the art **to try** to match the region boundary with the menu boundary in an attempt to provide an end user with a visual cue as to what the tracking boundary is, [so] that the end user can use the menu more efficiently."

In light of the discussion above, if one did try to make both the follow me and drag toolbar boundaries coincident, one would realize that this would make Strauss's Drag Toolbar unusable. Although the Supreme Court has recently indicated that an "obvious to try" rationale is permissible in an obviousness rejection, the Office Action's rationale is an improper "obvious to try" rationale, as such a "try" clearly would make Strauss's Drag Toolbar nearly impossible to use. (See MPEP, 2145 and *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007)). Thus, even if one of ordinary skill were to try such a modification, the modification would not be successful.

As noted in MPEP 2143.01,"if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, by making the "Drag Toolbar" and follow me boundaries coincident, this would effectively render Strauss unsatisfactory for its intended purpose of providing the "Drag Toolbar" "so as always to be within a certain distance from the cursor." Either the "Drag Toolbar" would stay continually with the cursor once the cursor enters the "Drag Toolbar" rather than stay a specified distance from the cursor, or fail to follow the cursor at all if modified as asserted by the Examiner.

In light of the above discussion, Examiner has failed to establish a *prima facie* case of obviousness because nothing cited or found in Iwema and Strauss, as modified by the Examiner's assertion, taken alone and in combination teaches "moving the menu when an outer edge of the menu is encountered."

Furthermore, nothing cited or found in Iwema teaches "displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated." Strauss also clearly does not teach this feature, because Strauss's Drag Toolbar only appears during a drag operation, and thus is visible when activated. Additionally, Selker also does not teach this feature.

The Office Action, on page 10, refers to column 5, lines 47-61 of Selker, which discusses nothing about the above claim features. Furthermore, Iwema, in column 11, lines 5-12 merely discusses that "whenever a user makes a menu choice that does not have an associated lower level menu, the menu having that choice disappears, but all higher level menus remain." Thus Iwema does not teach "displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated." Iwema merely discusses that a menu closes when a menu choice does not have a lower menu, which is unrelated to the above claim features.

Claim 30 emphasizes the features of "a menu move event when an outer edge of the menu is encountered the menu is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated" similar to those found in independent claim 1 and emphasizes a further additionally distinguishing feature.

In particular, claim 30 notes that the menu is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated. The Office Action on page 10 does not refer to the actual claim language of claim 30 and instead refers to language which is not even found in claim 30. Nothing cited or found in Selker, Iwema, Strauss, and Warnock discuss that the menu is visible when the control events indicate pan or zoom.

Thus, independent claim 30 patentably distinguishes over Selker, Iwema, Strauss, and Warnock.

4. Independent Claim 31

Independent claim 31 recites a computer readable storage controlling a computer. Furthermore, claim 31 recites moving the graphic on the display as a tracking menu responsive to movement of a pen when an outer edge of the surrounding ring graphic is encountered and the interface is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated.

Claim 31 emphasizes the features of "moving the graphic on the display as a tracking menu responsive to movement of a pen when an outer edge of the surrounding ring graphic is encountered" and "the interface is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or

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zoom is activated" similar to the features found in claim 1 and emphasizes a further additionally distinguishing feature.

In particular, claim 31 recites moving the graphic...when an outer edge of the surrounding ring graphic is encountered. The Office Action, on page 11, simply rejects claim 31 "along the same rationale" as in claim 30, however, as clearly shown above, claim 31 recites additionally distinguishing features which are not recited in claim 30. Thus, such a rejection is improper and Selker, Iwema, Strauss, and Warnock, taken alone and in combination, do not teach all features of claim 31.

Thus, independent claim 31 patentably distinguishes over Selker, Iwema, Strauss, and Warnock.

5. Independent Claim 32

Independent claim 32 recites a graphical user interface display. Further, claim 32 recites the tracking menu moving when an area immediately outside the menu is about to be reached and the menu is always visible when one of the controls is not activated and always not visible when one of the controls is activated.

Claim 32 emphasizes the features of "the tracking menu moving when an area immediately outside the menu is about to be reached and the menu is always visible when one of the controls is not activated and always not visible when one of the controls is activated" found in claim 1 and emphasizes a further additionally distinguishing feature.

In particular, claim 32 recites a zoom control in a center and a pan control surrounding the zoom control. The Office Action, on page 11, admits that Selker, Iwema, and Strauss do not teach pan and zoom operations. The Office Action on page 12, asserts that Warnock cures the deficiencies of Selker, Iwema, and Strauss. However, Warnock merely discusses a toolbar with zoom buttons and does not discuss "a zoom control in a center and a pan control surrounding the zoom control." Warnock, Selker, Iwema, and Strauss do not discuss that a zoom control is in the center of a pan control which surrounds the zoom control.

Thus, independent claim 32 patentably distinguishes over Selker, Iwema, Strauss, and Warnock.

6. Dependent Claim 5

Dependent claim 5 is at least patentable due to its dependency from independent claim 1. Furthermore, claim 5 also recites additional features not taught or suggested by Selker, Iwema, Strauss, and Warnock. Claim 5 recites "the first function is a zoom function and the

second function is a pan function." Nothing cited or found in Warnock discusses that the second function is a pan function.

7. Dependent Claim 23

Dependent claim 23 is at least patentable due to its dependency from independent claim 22. Furthermore, claim 23 also recites additional features not taught or suggested by Selker, Iwema, Strauss, and Warnock. In particular, claim 23 recites "a corresponding pan and zoom tracking symbol icon as a replacement for the tool during the performing." The Office Action cites Figure 7 of Strauss which shows a copy and paste icon which is not a pan and zoom tracking symbol icon. Warnock does not say that a pan and zoom tracking symbol icon is displayed during zooming and panning.

8. Dependent Claim 24

Dependent claim 24 is at least patentable due to its dependency from independent claim 22. Furthermore, claim 24 recites additional features not taught or suggested by Selker, Iwema, Strauss, and Warnock. In particular, claim 24 recites "replacement occurs when the tool is pinned." The Office Action asserts that "Strauss teaches the tool can be pinned" in column 6, lines 17-29. However, Strauss in column 6, lines 17-29 does not discuss that the Drag Toolbar can be pinned:

> Toolbar 30 can be made "nudge" sides, such that the Drag Toolbar
> 30 moves aside if the cursor 4 approaches from that side, while
> one or more "open" or "non-nudge" sides allow entry by the cursor
> 4 into the Drag Toolbar 30. As still another alternative, the Drag
> Toolbar 30 may have a "hook" control that allows the Drag Toolbar
> 30 to be itself dragged around the display during a drag operation.
> For example, the "hook" control might be shaped like a "C", such
> that moving the cursor 4 into the opening of the control engages a
> drag function for the Drag Toolbar 30; moving the cursor 4 back
> out of the opening disengages that drag function. Comparable
> approaches for all of these functions may also be used.

Nothing in the above discusses "replacement occurs when the tool is pinned" and claim 24 patentably distinguishes over Selker, Iwema, Strauss, and Warnock.

9. Dependent Claim 28

Dependent claim 28 is at least patentable due to its dependency from independent claim 22. Dependent claim 28 also recites additional features not taught or suggested by Selker, Iwema, Strauss, and Warnock. In particular, claim 28 recites "the tool can be pinned and the tool is unpinned when the transducer moves beyond an unpin border." The Office Action, on page

10, asserts that Strauss teaches in column 6, lines 17-29, that "the tool can be pinned and unpinned when the transducer moves over the 'hook' button." However, column 6, lines 17-29 of Strauss merely note that moving the cursor 4 into the opening of the control engages a drag function for the Drag Toolbar, and moving the cursor back out of the opening disengages that drag function." However, if Strauss is modified as asserted by the Office Action, one would never be able to move out of the opening once they went in, because the Drag Toolbar would constantly be right under the cursor.

D. Rejection of Claims 25-27 under 35 U.S.C. § 103(a) over Selker, Iwema, Strauss, Warnock and Mullet

1. Dependent Claim 25

Dependent claim 25 is at least patentable due to its dependency from independent claim 22. Dependent claim 25 also recites additional features which are not taught or suggested by Selker, Iwema, Strauss, Warnock, and Mullet, taken alone and in combination. In particular, claim 25 recites "designating a zoom control axis responsive to initial movement of the input transducer after the zoom operation is selected." The Office Action, on page 13, asserts that Mullet teaches a zoom control axis by referring to magnification adjustment slider 17 in Figure 2a of Mullet. However, Mullet says nothing about the zoom control being "responsive to initial movement of the input transducer." Thus claim 25 independently is patentable over Selker, Iwema, Strauss, Warnock, and Mullet.

2. Dependent Claim 26

Dependent claim 26 is at least patentable due to its dependency from independent claim 22. Dependent claim 26 also recites additional features which are not taught or suggested by Selker, Iwema, Strauss, Warnock, and Mullet, taken alone and in combination. In particular, claim 26 recites "controlling a zoom scale factor responsive to a projection of transducer movements onto the control axis." Although the Office Action on page 13 asserts that Mullet, in column 5, lines 10-15 teaches the above features of claim 26, Mullet merely discusses that the magnification adjustment slider 17 and a toggle switch 19 are set using the cursor on the display. It is submitted that claim 26 is independently patentable over Selker, Iwema, Strauss, Warnock, and Mullet.

3. Dependent Claim 27

Dependent claim 27 is at least patentable due to its dependency from independent claim 22. Claim 27 also recites additional features not taught or suggested by Selker, Iwema, Strauss,

Warnock, and Mullet. In particular, claim 27 recites "the tool includes a replaceable control and said method further comprises designating the replaceable control as the most recently selected pan and zoom operation." The Office Action asserts that Selker teaches the above features in column 3, lines 35-43. However, Selker merely notes that a menu item of predetermined criteria or highest frequency of use is in circle 10. Selker does not say that circle 10 is replaceable or that the circle is the most recently selected pan and zoom operation. It is submitted that claim 27 is independently patentable over Selker, Iwema, Strauss, Warnock, and Mullet.

E. Rejection of Claims 6 and 13 under 35 U.S.C. § 103(a) over Selker, Iwema, Strauss, Warnock, Schirmer and Beaton.

1. Dependent Claim 6

Dependent claim 6 is at least patentable due to its dependency from independent claim 1. Claim 6 also recites additional features not taught or suggested by Selker, Iwema, Strauss, Warnock, Schirmer, and Beaton, taken alone and in combination. The Office Action on page 14, admits that Selker, Iwema, Strauss, and Warnock do not explicitly teach that "the interface is semi transparent when the functions are not activated, transparent when the functions are activated and one of a zoom and pan icon replaces the tracking symbol when the functions are activated." However, the Office Action asserts that Schirmer cures the deficiencies in column 4, lines 31-58 and Figure 5 and that Beaton cures the deficiencies in column 5, lines 14-27. However, as discussed above with respect to Strauss, the Drag Toolbar only appears during a drag operation, opposite of the features of claim 6, which depends upon claim 1, which recites "controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated." Thus, when Strauss is combined with Schirmer and Beaton, the controls are visible during a Drag Operation, and not visible when a Drag Operation is not occurring. Strauss opposes the additionally distinguishing features of claim 6, which include "the interface is semi transparent when the functions are not activated, transparent when the functions are activated and one of a zoom and pan icon replaces the tracking symbol when the functions are activated."

2. Dependent Claim 13

Dependent claim 13 is at least patentable due to its dependency from independent claim 1. Dependent claim 13 also recites additional features not taught or suggested by Selker, Iwema, Strauss, Warnock, Schirmer, and Beaton. In particular, claim 13 recites "the interface is transparent when the one of the functions are activated and semitransparent when the functions are not activated." Claim 13 patentably distinguishes over the above references for similar

reasons as discussed above with respect to claim 6. Strauss, when combined with Schirmer and Beaton, would cause the Drag Toolbar to be non-transparent during a drag operation, and transparent when a drag operation is not occurring, in opposition to the additionally distinguishing features recited in claim 13.

F. Summary

In view of the foregoing remarks, Appellant submits that pending appealed claims 1-7, 9-18, and 20-34 are patentable over the relied upon cited references. Reversal of the Examiner's rejection is respectfully requested.

The Commissioner is authorized to charge any Appeal Brief fee or Petition for Extension of Time fee for underpayment, or credit any overpayment, to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____8/11/9_____   By: _____
                                    J. Randall Beckers
                                    Registration No. 30,358

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

VIII.   CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii))

1.   (currently amended) A graphical user interface ~~displayed on a~~ display, comprising:

a first region control initiating a first function when activated;

a second region control associated with the first region control having an outer edge and initiating a second function;

a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge and the ~~menu~~ interface and controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated; and

a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions.

2.   (Original) A user interface as recited in claim 1, wherein the second region control surrounds the first region control.

3.   (Original) A user interface as recited in claim 2, wherein the first region control is circular in shape.

4.   (Original) An interface as recited in claim 1, wherein the second region control is a most frequently used function.

5.   (Original) An interface as recited in claim 1, wherein the first function is a zoom function and the second function is a pan function.

6.   (Original) An interface as recited in claim 1, wherein the interface is semi transparent when the functions are not activated, transparent when the functions are activated and one of a zoom and pan icon replaces the tracking symbol when the functions are activated.

7.   (Original) An interface as recited in claim 1, wherein the first region control is circular shaped and the second region control is ring shaped.

8.   (Original) An interface as recited in claim 7, wherein the second region control is made invisible during movement and an icon for the second region control is displayed when the tracking symbol is over the second region control.

9.   (Original) An interface as recited in claim 7, wherein the second region control is segmented into ring segments each being a different control.

10.   (Original) An interface as recited in claim 7, further comprising a ring control having a ring shape surrounding the second control region and initiating a third function when activated.

11. .   (Original) An interface as recited in claim 10, further comprising a button control initiating a third function when activated and located on a boundary between the first and second region controls.

12.   (Original) An interface as recited in claim 10, further comprising a button control initiating a third function when activated and located within a region.

13.   (previously presented) An interface as recited in claim 1, wherein the interface is transparent when the one of the functions are activated and semitransparent when the functions are not activated.

14.   (Original) An interface as recited in claim 1, further comprising a button control initiating a third function when activated and located on a boundary between the first and second region controls.

15.   (previously presented) An interface as recited in claim 1, further comprising button controls initiating a function when activated and located on a boundary between the first and second region controls and creating access channels for movement of the tracking symbol within the interface.

16.   (Original) An interface as recited in claim 1, wherein the second region control has an exterior graphic edge and the tracking boundary coincides with the exterior graphic edge.

17.   (Original) An interface as recited in claim 1, wherein the interface is invoked by pressing an activation key.

18.   (Original) An interface as recited in claim 1, wherein the interface is displayed while an activation key is active.

19.   (currently amended) A graphical user interface displayed on a display, comprising:
        a circular shaped first region control initiating a zoom function when activated;
        a ring shaped second region control surrounding the first control region control and initiating a pan function when activated;
        a ring control having a ring shape surrounding the second control region having an outer edge and initiating a third function when activated, the third function being a most frequently used function;
        a button controls initiating an additional functions when activated, located on a boundary between the first and second region controls and creating access channels for movement of the tracking symbol within the interface;
        a tracking menu boundary surrounding the ring control and coincident with the outer edge and the menu and interface and controls are always visible when one of the controls is not activated and always not visible when one of the controls is activated,
        wherein the interface is semi transparent when the functions are not activated, transparent when the functions are activated and function icon replaces the tracking symbol when the functions are activated,
        wherein the second region control is made invisible during movement and an icon for the second region control is displayed when the tracking symbol is over the second region control, and
        wherein the second region control has an exterior graphic edge and the tracking boundary coincides with the exterior graphic edge.

20.   (currently amended) A user interface displayed on a display, comprising:
        a movable control having a first function activatable in an entire peripheral region of the control and a second function activatable in a central region of the control having an exterior edge; and
        a tracking symbol movable within the control and moving the control when the exterior

edge of the peripheral region is encountered and the control is always visible when one of the functions is not activated and always not visible when one of the functions is activated.

21.   (Currently Amended) A user interface displayed on a display, comprising:

a tracking menu having a first function activatable in an entire peripheral region of the menu and having an exterior edge, a second function activatable in a central region of the menu and a tracking symbol tracking a position of a user positionable input transducer and causing the menu tool to move when the exterior edge is encountered and the menu is always visible when one of the functions is not activated and always not visible when one of the functions is activated.

22.   (previously presented) A method, comprising:

displaying a pan-zoom tracking menu tool having an exterior edge;

allowing a user to select pan and zoom operations using the tracking menu tool and an input transducer;

performing a selected one of the pan and zoom operation responsive to movements of the input transducer by the user and causing the menu to move when the exterior edge is encountered;

presenting the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated.

23.   (Original) A method as recited in claim 22, displaying a corresponding pan and zoom tracking symbol icon as a replacement for the tool during the performing.

24.   (Original) A method as recited in claim 23, wherein replacement occurs when the tool is pinned.

25.   (Original) A method as recited in claim 22, further comprising designating a zoom control axis responsive to initial movement of the input transducer after the zoom operation is selected.

26.   (Original) A method as recited in claim 25, further comprising controlling a zoom scale factor responsive to a projection of transducer movements onto the control axis.

27.   (previously presented) A method as recited in claim 22, wherein the tool includes a replaceable control and said method further comprises designating the replaceable control as the most recently selected pan and zoom operation.

28.   (Original) A method as recited in claim 22, wherein the tool can be pinned and the tool is unpinned when the transducer moves beyond an unpin border.

29.   (previously presented) An apparatus, comprising:
a display;
a pen type input transducer; and
a computer coupled to the display and transducer and providing a pan-zoom tracking menu on the display and allowing a user to select and perform pan and zoom operations using the transducer input and moving the menu when an outer edge of the menu is encountered displaying the menu as always visible when one of the operations is not activated and always not visible when one of the operations is activated.

30.   (previously presented) A computer readable storage controlling a computer via a pan-zoom tracking menu having the appearance of a center and a surrounding ring and interpreting transducer input events as pan and zoom selection and control events and interpreting transducer motion as a menu move event when an outer edge of the menu is encountered the menu is always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated.

31.   (Currently Amended) A computer readable storage controlling a computer by producing a graphical user interface on a display that has an appearance of a center and a surrounding ring graphic, moving the graphic on the display as a tracking menu responsive to movement of a pen when an outer edge of the surrounding ring graphic is encountered, and interpreting input events initiated by the pen as pan and zoom selection and control events, the interface is [[are]]always visible when one of the control events indicates pan or zoom is not activated and always not visible when one of the control events indicates pan or zoom is activated.

32   (currently amended) A graphical user interface displayed on a display,

comprising:

a pan-zoom tracking menu having a zoom control in a center and a pan control surrounding the zoom control and with the tracking menu moving when an area immediately outside the menu is about to be reached and the menu is always visible when one of the controls is not activated and always not visible when one of the controls is activated.

33.   (previously presented) A graphical user interface display displaying an interface, comprising:

a first region control initiating a first function when activated;

a second region control associated with the first region control having an outer edge and initiating a second function;

a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge; and

a tracking symbol tracking a position of a position transducer moved by a user, movable within the first and second region controls, initiating movement of the interface to track the tracking symbol when the boundary is encountered by the tracking symbol during movement of the tracking symbol and indicating event focus for activating and performing the first and second functions.

34.   (currently amended) A user interface as recited in claim 1, wherein said initiating movement of the interface to track the tracking symbol occurs when the ~~menu~~ interface and controls are not visible.

IX. EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))

None

X. RELATED PROCEEDINGS APPENDIX (37 C.F.R. § 41.37(c)(1)(x))

Application 10/684,580 is currently pending and a Notice of Appeal was filed on May 11, 2009.